

REMARKS

Claims 1-26 are currently pending in the subject application and are presently under consideration. Claims 1, 4, 11, 20, and 26 have been amended as shown on pp. 2-5 of the Reply.

Applicants' representative thanks the Examiner for the courtesies extended during the telephonic interview on April 26, 2007, between Jennifer T. Nguyen and Applicants' representative Bradley D. Spitz. During the interview, the rejection of claims 25 and 26 under 35 U.S.C. §101 was discussed. In addition, independent claim 1 and potential amendments thereto in view of the cited references were discussed.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 25-26 Under 35 U.S.C. §101

Claims 25-26 stand rejected under 35 U.S.C. §101 for being directed to non-statutory subject matter. Withdrawal of this rejection is requested for at least the following reasons.

The subject matter of claims 25 and 26 is patentable because it can be used in a practical application to produce a useful, tangible, and concrete result. In *Eolas Techs., Inc. v. Microsoft Corp.*, 399 F.3d 1325 (Fed. Cir. 2005), the Federal Circuit held that software code can be patentable subject matter:

Title 35, section 101, explains that an invention includes "any new and useful process, machine, manufacture or composition of matter." . . . Without question, *software code alone qualifies as an invention eligible for patenting under these categories*, at least as processes. *Id.* at 1338 (emphasis added).

According to *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), the legal standard set forth by the Federal Circuit for determining whether claims are directed to statutory subject matter is whether the claims can be applied in a practical application to produce a useful, concrete and tangible result. Claims 25 and 26 meet this standard because they relate to enhanced information browsing on portable devices, which is a practical application that produces a useful, concrete, and tangible result.

Further, with regard to claim 25, the Federal Circuit has held that signals, like software code, can be patentable subject matter. Specifically, in *Arrhythmia Research Tech. Inc. v. Corazonix Corp.*, 958 F.2d 1053, 1059 (Fed. Cir. 1992), the Federal Circuit stated:

The view that “there is nothing necessarily physical about ‘signals’” is incorrect. In re Taner, 681 F.2d 787, 790, 214 U.S.P.Q. 678, 681 (CCPA 1982). . . . The computer-performed operations transform a particular input *signal* to a different output *signal*, in accordance with the internal structure of the computer as configured by electronic instructions. “The claimed invention . . . converts one *physical thing* into another *physical thing* just as any other electrical circuitry would do.” (Citations omitted) (emphasis added).

In *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998), *cert. denied*, 525 U.S. 1093 (1999), the Federal Circuit remarked upon its decision in *Arrhythmia*, noting that the transformation of signals in *Arrhythmia* was patentable as “a practical application of an abstract idea . . . because it corresponded to a useful, concrete or tangible thing”

Thus, the Federal Circuit case law supports that a signal can qualify as patentable subject matter. As noted *supra*, the Federal Circuit has made clear that signals can be patentable products of manufacture in and of themselves. As noted above, claim 25 is directed to a signal, encapsulated in a data packet, that provides enhanced information browsing on portable devices. Consequently, the subject claim clearly meets the aforementioned legal standards set forth in *AT&T Corp. v. Excel Communications, Inc.*, *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, and *Arrhythmia Research Tech. Inc. v. Corazonix Corp.*

In further support of the above argument, the PTO’s *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility* includes the following excerpt:

A signal, a form of energy, does not fall within either of the two definitions of manufacture. Thus, a signal does not fall within one of the four statutory classes of § 101. *On the other hand, from a technological standpoint, a signal encoded with functional descriptive material is similar to a*

computer-readable memory encoded with functional descriptive material, in that they both create a functional interrelationship with a computer. In other words, a computer is able to execute the encoded functions, regardless of whether the format is a disk or a signal.

This passage demonstrates that the PTO recognizes the distinction between a signal *per se* and a signal having *functional descriptive material that executes encoded functions*. Thus, the PTO acknowledges the eligibility of such subject matter.

Similarly, claim 26, which has been amended for clarity, recites *a computer-readable medium having stored thereon the components of claim 1, wherein the components are computer executable*. The components of claim 1, like the claimed aspects of claims 25 and 26, provide for enhanced information browsing on portable devices. Moreover, the Examiner does not assert that claim 1 is directed to non-statutory subject matter. Thus, in view of the above argument, the fact that claim 26 recites the components of claim 1 stored on a computer-readable medium does not change the fact that those components, and by extension claim 26 itself, are statutory subject matter. Accordingly, withdrawal of this rejection is respectfully requested.

II. Rejection of Claims 1, 2, 4, 9-11, and 20 Under 35 U.S.C. §102(e)

Claims 1, 2, 4, 9-11, and 20 stand rejected under 35 U.S.C. §102(e) as being anticipated by Lection *et al.* (U.S. 7,089,507). Withdrawal of this rejection is requested for at least the following reasons. The cited reference does not disclose or suggest all features recited in the subject claims as amended.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that “*each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (*quoting Verdegaaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added).

Amended independent claim 1 (and its corresponding dependent claims) recites: *An advanced navigation system for portable devices comprising: an input component that receives user input, the input component comprising a pointing device; a navigation component that facilitates navigating through content displayed on a portable device*

screen based in part on speed and location of the input component with respect to the content; and a mapping component that smoothly transitions a current view to a new or previous view and orients the content and/or the view thereof within the portable device screen based in part on data received from the navigation component, the mapping component continuously adjusts magnification of the content based at least in part on the speed of the input component with respect to the content. The subject amendments are supported by the specification. For example, the specification discloses that smooth and fluid-like changes to the detail of displayed content can be made based on the speed at which a pointing device, such as a stylus, moves across the content. (See p. 24, ll. 6-10). Further, these changes in detail can correspond to changes in zoom level or magnification. (See p. 24, ll. 28-29).

Lecture *et al.* relates to a map viewing interface wherein a user can select, pan, and/or zoom a digital map with a single stylus movement. (See abstract; col. 1, ll. 52-55). Lecture *et al.* further discloses that changes to the magnification of the map can be made from the interface by moving a stylus along a “zoom circle” that is provided in the interface after an area of the map is selected for display. (See figs. 2A-2B; col. 4, l. 67 – col. 5, l. 53). However, amended independent claim 1 recites *a navigation component that facilitates navigating through content displayed on a portable device screen based in part on speed and location of the input component with respect to the content and a mapping component that . . . continuously adjusts magnification of the content based at least in part on the speed of the input component with respect to the content.* Lecture *et al.* is silent regarding such features. More particularly, the magnification changes disclosed in Lecture *et al.* depend only on the position of the stylus on the zoom circle; the speed of the stylus is not taken into consideration. Further, the changes in magnification disclosed in Lecture *et al.* are not made continuously. Rather, changes in magnification are only made when a new area of the map is selected.

Likewise, independent claims 11, 20, and 26 have been amended in a similar manner to independent claim 1. Thus, Lecture *et al.* does not disclose or suggest all features of said claims for the reasons stated above. In view of the foregoing, Applicant’s representative respectfully requests that this rejection be withdrawn.

III. Rejection of Claims 3, 5-7, 12-16, 18, and 21-24 Under 35 U.S.C. §103(a)

Claims 3, 5-7, 12-16, 18, and 21-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lektion *et al.* (U.S. 7,089,507) in view of Baar *et al.* (U.S. 6,768,497). Withdrawal of this rejection is requested for at least the following reasons. The cited references, either alone or in combination, do not disclose or suggest all features recited in the subject claims as amended.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP 706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Claims 3, 5-7, 12-16, 18, and 21-24 depend from independent claims 1, 11, and 20. For the reasons set forth in Section II *supra*, Lektion *et al.* does not disclose or suggest all features of said independent claims. Further, Baar *et al.* does not cure the deficiencies noted in Section II for at least the following reasons.

Baar *et al.* relates to techniques for displaying content on a computer screen, wherein a region of interest can be selected from the content and displayed at a higher level of detail and/or magnification as compared to the remainder of the content. (See abstract; col. 2, ll. 24-34; col. 8, ll. 17-19). Baar *et al.* further discloses that a user can request a change in magnification of displayed content by executing a particular keystroke or by executing a "tap" with a pointing device such as a stylus. Once the magnification change request is made, the user may then adjust the magnification by making a straight line stroke with a pointing device. The magnification is then adjusted based on the length or speed of the straight line stroke. (See col. 8, ll. 22-28). However, independent 1 recites *the mapping component continuously adjusts magnification of the content based at least in part on the speed of the input component with respect to*

the content. Llection *et al.* and Baar *et al.*, either alone or in combination, do not disclose or suggest such features. In particular, Baar *et al.*, like Llection *et al.*, discloses that a magnification adjustment is only performed when a request for a magnification adjustment is made, *i.e.*, when a user executes a predetermined keystroke or stylus tap to initiate the magnification request. In contrast, because the magnification adjustment recited in independent claim 1 can be performed on displayed content *continuously* based on the rate at which an input device is moved across the content, such an adjustment can be performed automatically without requiring a request for a magnification adjustment from the user. Thus, the cited references do not disclose or suggest all features recited in independent claim 1.

Likewise, independent claims 11, 20, and 26 have been amended in a similar manner to independent claim 1. Thus, the cited references, either alone or in combination, do not disclose or suggest all features of said claims, and correspondingly all claims from which said claims depend, for the reasons stated above. In view of the foregoing, Applicant's representative respectfully requests that this rejection be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP593US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

Amin, Turocy & Calvin, LLP

/Himanshu S. Amin/

Himanshu S. Amin

Reg. No. 40,894

Amin, Turocy & Calvin, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731